

Remarks

Claims 1-55 are pending in the application. Claims 7, 17, 18, 30, 31, and 37 have been amended.

Claims 17 and 30 were amended by replacing “and” with “or” in the definitions of R₁, R₂, R₃, and R₄. Similarly, claims 18 and 31 were amended by replacing “and” with “or” in the definitions of R₁ and R₂. The amendment to claims 17, 18, 30, and 31 was made to bring the claims into compliance with proper Markush Group form.

The specification was amended to correct two typographical errors. The spelling of “cyatalysts” appearing on page 12 of the specification was corrected. The symbol “H” in compound 2 of Scheme 4 was replaced with “R.” The fact that “H” should have been “R” in compound 2 of Scheme 4 is supported by the fact that the substituent attached to the C-C double bond in compounds 3-5 is “R.”

Support for the claim amendments can be found throughout the application. Therefore, no new matter has been added. Importantly, the claim amendments should not be construed to be an acquiescence to any of the claim rejections. Rather, the amendments to the claims are being made solely to expedite the prosecution of the above-identified application. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

Claim Rejections Based on 35 USC § 112¶2

Claim 7 was rejected under 35 USC § 112¶2, based on the Examiner’s contention that “variable ‘L’ is not defined in claim 6, [upon] which claim 7 depends, but rather the variables X, X’ and M.” Furthermore, the Examiner asserts that “it appears that the variable ‘X’ was intended.” Applicants thank the Examiner for pointing out the typographical error. Claim 7 was amended by replacing “L” with variable “X.” Support for the claim amendment can be found on page 3 of the application as filed. Therefore, no new matter has been added. Accordingly, Applicants request withdrawal of the rejection of claim 7 based on 35 USC § 112¶2.

Claim Rejections Based on 35 USC § 102(b)

Claims 37, 38, 40, and 42 were rejected under 35 USC § 102(b) based on the Examiner's contentions that they are anticipated by Krouse et al., Journal of Organometallic Chemistry, 335 (1988), 257-265. The Examiner contends that Krouse et al. discloses "trans-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃; cis,cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃ and -(Me₃CO)₃W≡C(1,2-C₆H₄)C≡W(OCMe₃)₃." The Examiner also refers to compounds 2, 4, and 9 in the experimental section of Krouse et al. To organize the Applicants' traverses of the Examiner's rejections under 35 USC § 102(b), they are set forth below in paragraphs labeled according to the compound serving as the basis of the rejection in the Office Action.

A. Response to Examiner's contention that claims 37, 38, 40, and 42 are anticipated by "trans-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃" referred to as compound 2 in Krouse et al.

In order to expedite prosecution, the Applicants have amended claim 37 to remove H from the definition of R₁ and R₂. Compound 2 of the Krouse article does not fall within the scope of amended claim 37 because compound 2 has hydrogen atoms attached to the carbon atoms of the ethylene core, i.e., --CH=CH--. Therefore, compound 2 of the Krouse article does not form the basis of a proper 35 USC § 102(b) rejection of claim 37 or any claims that depend thereon because compound 2 does not fall within the scope of claim 37. Incidentally, the Applicants point out that compound 2 did not fall within the scope of claim 42 as originally filed because claim 42 requires that X is -N(*i*-Pr)₃,5-Me₂C₆H₃), whereas the ligand attached to tungsten in compound 2 is a -OCMe₃.

In light of the amendment to the definition of R₁ and R₂, claim 37 was amended to insert generic structure X in order to retain the original scope of the claim with respect to cis enedialkylidyne VIII. The definition of R₁ and R₂ in claim 37 as originally filed provides support for the definition of R₃ and the fact that a hydrogen atom can be attached to the C-C double bond in formula X. Accordingly, Applicants request withdrawal of the rejection of claims 37, 38, 40, and 42 under 35 USC § 102(b) based on compound 2 of Krouse et al.

B. Response to Examiner's contention that claims 37, 38, 40, and 42 are anticipated by "cis,cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃" in Krouse et al.

Applicants respectfully point out that “cis,cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃” is not a chemical compound disclosed in Krouse et al., and it is not the correct name of a chemical compound because the name contains two “cis” prefixes but only one C-C double bond.

In the event that the Examiner was referring to cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃, the Applicants point out that Krouse indicates on page 259 that they were unable to isolate the aforementioned compound. Importantly, the mere naming of a compound, or speculation of its presence as an intermediate, which was not able to be made, does not form the basis of a proper 35 USC § 102(b) rejection because such a disclosure fails to meet the requirements (e.g., the enablement requirement) of 35 USC § 112¶1. The Applicants respectfully remind the Examiner that “the disclosure in an assertedly anticipation reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it can’t be produced without undue experimentation.” *Elan Pharm., Inc. v. Mayo Foundation for Medical and Educational Research*, 346 F.3d 1051, 1054, 68 USPQ2d 596 (CCPA 1968).

In the event the Examiner meant cis,cis-(Me₃CO)₃W≡CCH=CHC≡CCH=CHC≡W(OCMe₃)₃, referred to as compound 4 in Krouse et al., the Applicants assert that compound 4 does not form the basis of a proper 35 USC § 102(b) rejection because compound 4 does not fall within the scope of claim 37. The Applicants point out that the tungsten atoms in compound 4 are separated by “≡CCH=CHC≡CCH=CHC≡” which does not fall within the scope of the carbon-tether separating the Group VI transition metals in claim 37. Further, compound 4 does not form the basis of a proper 35 USC § 102(b) rejection of claims 38, 40, and 42 because compound 4 does not meet all the limitations of independent claim 37, upon which claims 38, 40, and 42 depend.

Therefore, the Applicants contend that regardless of whether the Examiner intended “cis,cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃” to refer to cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃ or compound 4, neither cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃ nor compound 4 form the basis of a proper 35 USC § 102(b) for the reasons discussed above. Accordingly, Applicants request withdrawal of the rejection of claims 37, 38, 40, and 42 under 35 USC § 102(b) based on “cis,cis-(Me₃CO)₃W≡CCH=CHC≡W(OCMe₃)₃”.

C. Response to Examiner's contention that claims 37, 38, 40, and 42 are anticipated by “-(Me₃CO)₃W≡C(1,2-C₆C₄)C≡W(OCMe₃)₃” in Krouse et al.

The Applicants contend that “-(Me₃CO)₃W≡C(1,2-C₆C₄)C≡W(OCMe₃)₃” does not form the basis of a proper 35 USC § 102(b) because the aforementioned compound was not disclosed in Krouse et al. Accordingly, Applicants request withdrawal of the rejection of claims 37, 38, 40, and 42 under 35 USC § 102(b) based on “-(Me₃CO)₃W≡C(1,2-C₆C₄)C≡W(OCMe₃)₃.”

D. Response to Examiner's contention that claims 37, 38, 40, and 42 are anticipated by compound 9 in Krouse et al.

The Applicants contend that (Me₃CO)₃W≡C(1,2-C₆H₄)C≡C(1,2-C₆H₄)C≡W(OCMe₃)₃, referred to as compound 9 in Krouse et al., does not form the basis of a proper 35 USC § 102(b) because the rejection because compound 9 does not fall with the scope of claim 37. The Applicants point out that the tungsten atoms in compound 9 are separated by “≡C(1,2-C₆H₄)C≡C(1,2-C₆H₄)C≡” which does not fall with the scope of the carbon tether separating the Group VI transition metals in claim 37. Further, compound 9 does not form the basis of a proper 35 USC § 102(b) rejection of claims 38, 40, and 42 because compound 9 does not meet all the limitations of independent claim 37, upon which claims 38, 40, and 42 depend. Accordingly, Applicants request withdrawal of the rejection of claims 37, 38, 40, and 42 under 35 USC § 102(b) based on compound 9 in Krouse et al.”

Allowable Subject Matter

The Applicants are pleased that claims 1-6 and 8-36 have been allowed. In addition, the Applicants gratefully acknowledge the Examiner's indication that claims 39, 41, 42 and 44-55 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, the Applicants respectfully maintain that the amendments and arguments presented herein overcome all pending claim rejections in the application.

Fees

The Applicants believe that no fees are required in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any required fee to our Deposit Account, **06-1448**.

Conclusion

In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. Therefore, the Applicants respectfully request reconsideration and withdrawal of the pending rejections. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned.

Respectfully submitted,
FOLEY HOAG LLP



Dana M. Gordon, Ph.D.
Registration No. 44,719
Attorney for Applicants

Patent Group
FOLEY HOAG LLP
155 Seaport Boulevard
Boston, MA 02210

(617) 832-1000
(617) 832-7000 (FAX)

Date: 2/24/05